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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/859,616	05/16/2001	Randy D. Sines	CA67-008	3355

39279 7590 12/14/2007
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EXAMINER

KESACK, DANIEL

ART UNIT	PAPER NUMBER
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3691

MAIL DATE	DELIVERY MODE
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12/14/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/859,616

Applicant(s)

SINES ET AL.

Examiner

Dan Kesack

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The amendment filed May 21, 2007 has been entered and fully considered.

Claims 1-35 are currently pending. The rejections are as stated below.

Response to Arguments

2. Applicant's arguments, with respect to the rejection of claims 1-19 under 35 U.S.C. 103(a) have been fully considered and are persuasive, because Examiner is of the opinion that Michener et al. is not a proper reference. Therefore, the rejection has been withdrawn.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1 and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to

which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant's specification details that when the order delivery address is to be used as customer verification data, the delivery address is included as part of the order file which the merchant receives (Applicant's specification, paragraph 112). This is in contrast to Applicant's amendment, which now claims "verifying said order delivery address... without providing account verification information to the merchant".

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear from the claim language what is meant by "account verification information" because Examiner is unable to ascertain whether said verification information is one or more parts of the previously mentioned "order information", or if the account verification information is separate. For the purposes of examination and applying prior art, the "account verification information" will be interpreted as being any of the information which is used in the "verifying" steps. Furthermore, the claims recite "obtaining computerized order information", "obtaining an order delivery address", and "obtaining ordering computer global positioning satellite information." It is unclear who or what is performing the "obtaining" steps.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1, 2, 6-19, 23-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hultigren, U.S. Patent No. 6,868,391, in view of Carrott et al., U.S. Patent No. 6,839,692.

Claims 1, 19, Hultigren discloses a method and apparatus for facilitating payments, comprising:

creating a customer account, said customer account being associated with said customer (column 5 lines 53-62), the customer account also having customer computer global positioning satellite location identification information associating said customer

account with at least one authorized customer computer which is identifiable using global position satellite location information (column 10 line 63 – column 11 line 3);

creating a merchant account, said merchant account being associated with said merchant (figure 2, #224A-C; It is noted that the recitation that said merchant has a merchant internet site at which the merchant offers goods and services is regarded as non-functional descriptive language);

obtaining computerized order information placed from an ordering computer which indicates an order for chosen goods or services being sought for purchase by the customer using the merchant, said obtaining computerized order information including obtaining ordering computer global positioning satellite location information indicating location of the ordering computer (column 9 line 61 – column 10 line 9);

verifying said ordering computer global positioning satellite location information from the ordering computer by comparing said ordering computer global positioning satellite location information to said customer computer global positioning satellite information to assure it is an authorized customer computer location without providing account verification information to the merchant (column 11 lines 11-42);

communicating assurance of payment to the merchant in connection with said order upon successful verification of said ordering computer global positioning satellite location information without providing account verification information to the merchant (column 1 lines 60-64).

Hultigren fails to teach delivery address information being in the customer account, being obtained, and being verified. Carrott discloses a method and apparatus to provide secure purchase transactions over a computer network, wherein a customer account is created, said account having a customer delivery address information associated said customer account with at least one authorized customer delivery address (column 4 lines 1-4, column 7 lines 12-15), obtaining delivery address indicating a location for delivery of goods or services (column 6 lines 35-45, 62-63), and verifying the order delivery address by comparing the order delivery address to the customer delivery address information kept by the bank to assure it is an authorized customer delivery address without providing account verification information to the merchant (column 7 lines 1-39). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Hultigren to include using the customer delivery address as an addition form of account verification which would increase the security of the transactions being performed, with predictable results.

Furthermore, while Hultigren refers to the TSN which facilitates the verification of the transaction, and the financial institution separately, it would be obvious for the functions of the TSN to be performed by the bank, or for the TSN to be a part of the financial institution (column 6 lines 6-8). One of ordinary skill in the art at the time of the Applicant's invention would have recognized the benefits of a bank operating a TSN to

verify all the internet transactions of its customers, as this would increase security, and decrease fraudulent transactions.

Claim 2, Hultigren teaches crediting funds to the merchant account in payment of the order (column 8 line 66 – column 9 line 11).

Claims 6, 7, 23, 24, Hultigren fails to teach the customer building an order file. Carrott discloses this feature (column 5 lines 39-55). Furthermore, Carrott teaches building an order file with the merchant internet site, at least part of which is obtained by the bank (column 6 lines 35-67). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Hultigren to include building an order file, as taught by Carrott because Hultigren is used for purchasing goods and services from a merchant over the Internet, which includes placing an order, and Carrott teaches mechanics of order placing.

Claims 8, 25, Hultigren teaches customer, banker, and merchant are connected to a network, such as the Internet, which provides simultaneous connection between the entities (column 3 line 66 – column 4 line 25).

Claims 9, 13, 14, 26, 30, 31, Hultigren fails to teach the particulars of placing an order with the merchant. Carrott teaches communicating between the customer and the merchant to provide the merchant with a first portion of a merchant order file, and

communicating between a customer and a bank to create a bank customer order file, as cited in reference to claims 1 and 19, above. Carrott further teaches the bank providing the merchant with a second portion of the merchant order file (for example, authorization number), based in part on the bank customer order file (column 5 lines 65 – column 7 line 3). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Hultigren to include building an order file, as taught by Carrott because Hultigren is used for purchasing goods and services from a merchant over the Internet, which includes placing an order, and Carrott teaches mechanics of order placing.

Claims 10-12, 15-18, 27-29, 32-35, Hultigren fails to teach the financial institution using the customer stored information, but, as cited above, it would be obvious for the TSN network to be integrated within the financial institution. Carrott teaches a financial institution using stored customer account information. While Carrott fails to teach the account information coming from a second source which is not the internet, acquiring this information through non-internet sources, such as mail-in applications, telephone applications, and in-person interviews at the financial institution would all be obvious next steps when the customer establishes an account at the financial institution, and includes supplying customer account verification information through means other than the Internet. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Hultigren to include any method of

collecting information from a customer which is known in the art, and yields predictable results.

10. Claims 3-5, and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hultigren and Carrott, as applied to claims 1 and 19 above, and further in view of Tetro et al., U.S. Patent No. 6,095,413.

The combination of Hultigren and Carrott fail to teach using identification information other than delivery address and GPS location information to verify a transaction.

Tetro discloses a system and method for fraud detection in electronic transaction processing, wherein an account holder's personal parameters, such as social security number, address, and telephone number are obtained during a transaction, and are verified to match stored values for said parameters, in order to authorize the transaction (column 4 line 31 – column 5 line 43, column 7 lines 43-61). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Hultigren and Carrott to include the use of telephone and social security numbers for verifying a transaction because Tetro teaches the deficiencies of address-verifying-only systems, and the need to validate more inaccessible and personal information in order to ensure security (column 1 lines 41-67), and it would be obvious to use any known personally verifiable information datum as an additional layer of security within the context of the Hultigren method of verifying a transaction, yielding predictable results.

Conclusion


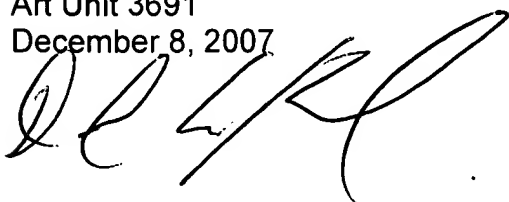
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully Submitted,

Daniel Kesack
Art Unit 3691
December 8, 2007



HANI M. KAZIMI
PRIMARY EXAMINER